



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/343,686	11/21/94	KELLER	G 287926

18M2/0429
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EXAMINER	
LANKFORD JR, L	
ART UNIT	PAPER NUMBER
1808	<i>13</i>
DATE MAILED:	04/29/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/343,686	Applicant(s) Keller et al
Examiner L. Blaine Lankford	Group Art Unit 1808



Responsive to communication(s) filed on May 6, 1996

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-106 is/are pending in the application.

Of the above, claim(s) 1-26 and 60-106 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 27-59 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 7-10

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1808

DETAILED ACTION

1. Applicant's election with traverse of group II, claims 27-59, in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the search would not be burdensome. This is not found persuasive because the inventions are considered distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches, as indicated by the different classification. The search for each of the above inventions is not co-extensive, particularly with regard to the literature search. Moreover, a reference that would anticipate the invention of any one group would not necessarily anticipate or even make obvious any of the other groups.

The requirement is still deemed proper and is therefore made FINAL.

Claims 27-59 are considered on the merits.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as not enabling the claimed invention.

The following objection relates to the non-enabling disclosure.

Art Unit: 1808

It is apparent that the cell line is required to practice the claimed invention. As a required element it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the cell line is not so obtainable or available, the requirements of 35 USC 112 may be satisfied by a deposit of the cell line. See 37 C.F.R. 1.802.

If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that:

- (a) during the pendency of this application, access to the invention will be afforded to one determined by the Commissioner to be entitled thereto;
- (b) all restrictions imposed by the depositor upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of at least thirty years or at least five years after the most recent request for the furnishing of a sample of the deposited material;

Art Unit: 1808

(d) a viability statement in accordance with the provisions of 37 C.F.R. 1.807; and
(e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

In addition the identifying information set forth in 37 C.F.R. 1.809(d) should be added to the specification. See 37 C.F.R. 1803-1.809 for additional explanation of these requirements.

3. Claims 27-59 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The reasons are set forth in the above objection to the specification.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27-59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wiles et al(R).

Applicant claims an embryonic blast cell population.

Art Unit: 1808

Wiles et al disclose an embryonic blast cell population which appear to be identical to applicant's claimed invention. The reference anticipates the claim subject matter.

However, even if the reference's populations and the claimed populations are not one and the same and there is, in fact, no anticipation, the reference preparations would, nevertheless, have rendered the claimed population obvious to one of ordinary skill in the art at the time the claimed invention was made in view of the clear close relationship between the cells.

Thus, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the references, especially in the absence of evidence to the contrary.

The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' populations differ and, if so, to what extent, from that discussed in the references. Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is shifted to Applicants.

7. Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Blaine Lankford whose telephone number is (703) 308-2455.

LBL

April 23, 1997


LEON B. LANKFORD, JR.
PRIMARY EXAMINER
GROUP 1800